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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,800	03/15/2005	Hikofumi Yamamoto	052277	9561

38834 7590 01/17/2007  
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP  
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WASHINGTON, DC 20036

EXAMINER
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BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/527,800

Applicant(s)

YAMAMOTO ET AL.

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/1/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Figures 6 and 7 should be designated by a legend such as --Prior Art--- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

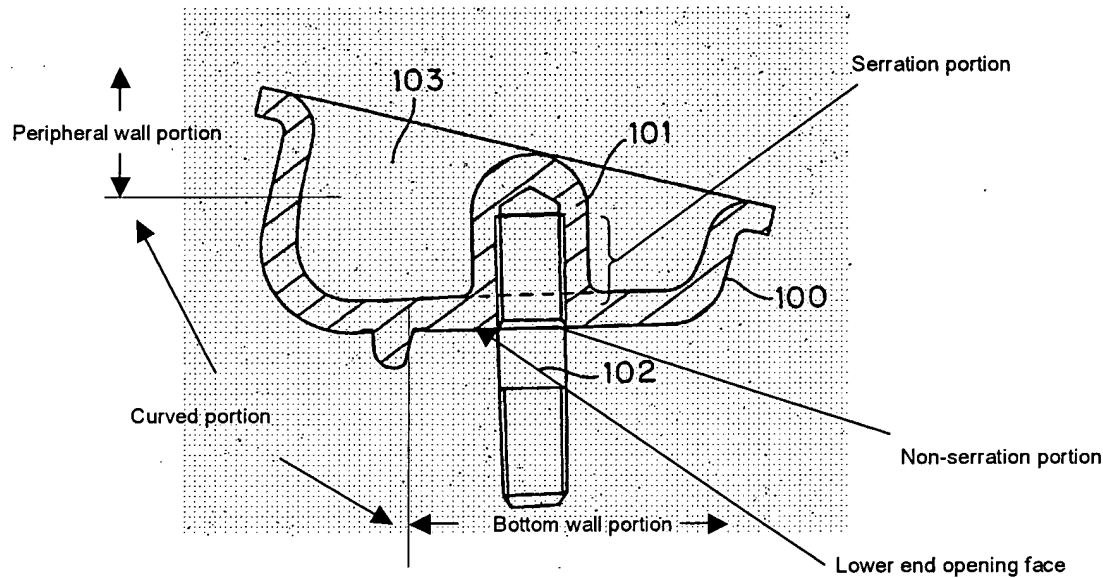
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3, 5, 6, 8, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior art figure 6 in view of JP-4114145 (JP'145).

Re: claims 3, 5, and 10. Prior art figure 6 shows a hydraulic vibration proof device comprising: a cup-shaped second attachment 100 forming an air chamber 103 which is characterized in that the second attachment fitting is fabricated from aluminum as disclosed in paragraph [0007] and includes a peripheral wall portion and a curved portion interposed between the bottom wall portion and the peripheral wall portion and

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curved in an arc form in axial cross-section, the bottom wall portion is defined with a hole and having a bolt.



Prior art figure 6 is silent with regards to the remaining structure of the vibration proof device and lacks the claimed through hole and bolt arrangement on the bottom wall portion.

JP'145 teaches in figure 1 the use of a vibration proof device comprising a cylindrical fitting 1, a first attachment fitting 9, a vibration isolating base made of rubber elastomer 2 coupling an upper end opening of the cylindrical fitting and the first attachment fitting, a diaphragm 3 disposed to oppose the vibration isolating base and forming a liquid chamber between the vibration isolating base and the diaphragm within the cylindrical fitting, and a cup-shaped second attachment 7 fitting attached to a lower end opening of the cylindrical fitting and forming an air chamber 8 between the second

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attachment fitting and the diaphragm, which is characterized with a bottom wall portion shown to the left of the lead line of number 7 defined with a through hole and has a bolt 11 having a serration portion 10 below its head press-fitted in the through hole and provided fixedly to the second attachment fitting in such a manner that the bolt juts out from the second attachment fitting downwardly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the structure of the vibration proof device of prior art figure 6 to have included a cylindrical fitting, a first attachment fitting, a vibration isolating base made of rubber elastomer, and a diaphragm as taught by JP'145, in order to provide a structure that provides damping between two vehicle components in an axial direction.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bolt and hole arrangement on the bottom wall portion to have been a bolt jutting out downwardly from a through-hole, as taught by JP'145, in order to provide a means of more effectively securing the bolt against fall out.

Re: claim 6. Prior art figure 6, as modified teaches in Prior art figure 6 the limitation wherein a length of the serration portion is set to be shorter than a depth of the hole, thus providing the non-serration bonding portion between the serration portion and a lower end opening face of the hole.

Re: claims 8 and 9. With regards to the relationship of the different device portions, Examiner maintains that obviousness is found on the basis of "routine experimentation with a very limited number of species". *In re Jones*, 162 USPQ 224

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(CCPA 1969). With regards to the optimum range of 3 and up or 5 and up, Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the bonding index to have been 3 or 5 and up since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior art figure 6 in view of JP-4114145 (JP'145) as applied above, and further in view of JP-2568225 (JP'225).

Prior art figure 6, as modified, lacks the limitation of a sealing agent between the bolt and the second attachment fitting.

JP'225 teaches in figure 2 the use of a sealing agent 15 between the bolt 11 and the second attachment fitting 7 shown in figure 1.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the space between the bolt and the second attachment fitting of prior art figure 6, as modified, to have included a sealing agent, as taught by JP'225, in order to provide a means of preventing the entrance of debris.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior art figure 6 in view of JP'079 as applied to claim 5 above, and further in view of US Patent 4762310 to Krajewski et al.

Prior art figure 6, as modified, teach the use of a lower end opening

face of the hole providing the non-serration bonding portion shown at the section within the hole in the bottom wall portion above section 102 of the bolt, but lacks the limitation of the lower end opening face being chamfered.

Krajewski et al. teach in the figure on the front of the patent the use of a through hole within element 26 which is shown on its lower end opening face as being chamfered.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the lower end opening of the hole of Prior art figure 6, as modified, to have been chamfered, as taught by Krajewski et al., in order to provide enhanced frictional engagement by making sufficient space in the chamfered portion to provide a sealing means, for example.

### ***Response to Arguments***

6. Applicant's arguments filed 11/1/06 have been fully considered but they are not persuasive.

In response to the drawing objection and the rejections using Prior art figure 6 Applicant argues that figure 6 is not prior art. Applicant further notes that the application explains that figure 6 is "merely a conceivable construction." Examiner notes that the conceivable construction is discussed in the background of the invention section of the application. MPEP 608.01(c) states that the background of the invention comprises a section about the field of the invention and a section describing related art. Accordingly, placing the explanation of figures 6 and 7 in the background of the invention suggests to one of ordinary skill that figures 6 and 7 include known information. Another fact that

supports Examiner's conclusion that Figures 6 and 7 are prior art is that in the brief description of the drawings section of the application Applicant admitted that figures 6 and 7 were "conventional." See pg. 5 lines 5 and 6 of the instant application. Section 704.11(b)(I)(F) of the MPEP talks about situations in which the specification's background of the invention "describes information as being known or *conventional*, which may be considered as an *admission of prior art*." Therefore, reliance on Figure 6 is not improper.

Applicant next states that it is "unclear whether the Office action argues that JP'145 discloses the recited changes in thickness." Examiner notes that JP'145 is not relied upon for teaching the recited changes in thickness. Examiner maintains that the thickness changing limitations are satisfied by the Prior art figure 6 as illustrated in the annotated copy of Prior art figure 6 provided on pg. 3 of the instant Office action.

Finally, with regards to claims 8 and 9 Applicant argues that the *Jones* case is not pertinent to whether it would have been obvious to design a cup-shaped attachment fitting having the claimed structure since *Jones* discusses whether it was obvious to select from types of asbestos. Examiner notes that *Jones* is used simply for the teaching that selecting input values to optimize conditions is known regardless of whether the input value is a type of asbestos or a bonding index amount stemming from a relationship between diameters and a length. Examiner further notes that the portion of the specification cited by the Applicant to provide support for criticality and unexpected results relates not to the significance of the bonding index (involving the through-hole and serration diameters and the axial length of the serration portion) being



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at least 3 or 5 but instead to the significance of the thick-walled structure of the curved portion being made of aluminum instead of iron. Since Applicant has failed to provide criticality particularly with respect to the limitations set forth in claims 8 and 9, the rejections based on the case law have been maintained.

7. Applicant's arguments, see pg. 11, filed 11/1/06, with respect to the rejection(s) of claim(s) 4 under 35 USC 103 using the JP'079 reference have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of JP'225.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mmb

January 10, 2007

*Melody M. Burch*  
**Melody M. Burch**  
**Primary Examiner**  
**Art Unit 3683**

1/10/07